

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

HEINEKEN TECHNICAL SERVICES, B.V.,

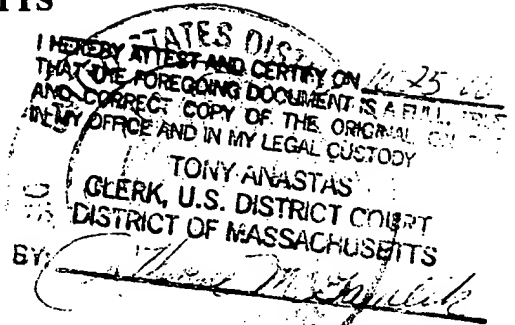
Plaintiff,

v.

CHARLES DARBY, DECOTEC
INTERNATIONAL LTD., and
WOLFGANG FIWEK,

Defendants.

Civil Action No.
C.A. 98-11952-JLT



DECLARATORY JUDGMENT (PROPOSED)

Whereas, Plaintiff Heineken Technical Services, B.V. ("Heineken") has alleged in its Complaint that it is the owner through assignment from Brandt Technologies, Inc. of a process and device for applying labels to bottles or packages/containers in which the conveying direction of the transport line of bottles is opposite to the conveying direction of the labels (the "Invention"); and

Whereas Heineken alleges that defendants Charles Darby ("Darby"), a citizen of the United States, and Wolfgang Fiwek ("Fiwek"), a citizen of Germany, breached a non-disclosure agreement and misappropriated the Invention and related trade secrets, all of which are the rightful property of Heineken; and

Whereas Fiwek caused to be filed U.S. Patent Application 08/930,464, PCT International Patent Application PCT/DE 96/00365, European Patent Application 819 082 (filed as application number 96 904 725), and has obtained German Patent 19 509 984 -- each of which incorporates elements of the Invention; and

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Whereas Wolfgang Fiwek's United States Patent Application has matured into U.S.

Patent 6,098,689 ("the '689 Patent"); and

Whereas Fiwek entered into an Assignment Agreement, dated January 31, 1997, in which he assigned all of his interests (whether actual or putative) in an invention, further described by Fiwek as a rotary heat transfer decorating process, machines for applying the process and related inventions, including German Patent 19 509 984, PCT International Patent Application PCT/DE96/00365 and any derivative national or regional patents which issued therefrom, including European Patent Application 819 082, to DecoTec International L.P. ("DecoTec") and irrevocably appointed DecoTec and its general partner Charles Darby as his agent and attorney in fact for the purpose of executing documents pertaining to the patent applications and intellectual property rights relating to the assigned process and machines; and

Whereas Defendants Darby and DecoTec wish to resolve this action and have submitted a declaration in support of this Declaratory Judgment (the "DecoTec Declaration") in which they request this Court to enter a judgment that ownership of United States Patent Application 81/930,464 (now the '689 Patent) shall be vested in Heineken and recorded on the rolls of the United States Patent & Trademark Office; and

Whereas Darby and DecoTec have further requested the Court to enter a judgment that, pursuant to the Assignment Agreement and the DecoTec Declaration, Heineken has become the owner of German Patent 19 509 984, PCT International Patent Application PCT/DE 96/00365 and any derivative national or regional patents which issued therefrom, including European Patent Application 819 082, and may apply through its Counsel to have such assignments recorded in the German, European or other appropriate patent offices; and

Whereas Heineken alleges that Fiwek is in knowing and willful default of his obligation to produce relevant documents pursuant to Rule 26(a) and (e) of the Federal Rules of Civil Procedure and Local Rule 26 of this Court through his refusal to produce the full file history or any file history documents subsequent to May 1999 pertaining to U.S. Patent Application 08/930,434; and

Whereas Heineken has requested over a period of months that Fiwek produce a full and complete file history of Fiwek's U.S. Patent Application and Fiwek has failed to comply, notwithstanding his obligation to do so; and

Whereas Fiwek failed to respond to this Court's Order of August 3, 2000, or to Plaintiff's repeatedly renewed demand for production of relevant documents; and

Whereas Heineken is suffering irreparable injury in that Fiwek's refusal to produce the file history of the U.S. Patent Application or to execute the requisite documents in favor of DecoTec or its designee (notwithstanding Fiwek's obligation to do so under the Assignment Agreement with DecoTec) subjects Heineken to loss or abandonment of various claims which may be asserted in the patent application; and

Whereas Fiwek was served with process, and has appeared through counsel in this action, and it appearing to the Court that defendant Fiwek is in willful violation of the Federal and Local Rules; this Court's Order of August 3, 2000; and his obligations under the Assignment Agreement of January 31, 1997;

Now Therefore, upon consideration of Plaintiff's Motion for Declaratory and Partial Summary Judgment and to Set Trial Date for Recovery Issues; the Assignment Agreement of January 31, 1997; the DecoTec Declaration; and following a hearing, it is hereby decreed and adjudged:

1. That Wolfgang Fiwek, of Obere Lindenstraße 2, 21521 Wohltorf, Federal Republic of Germany (as admitted in his Answer to the Complaint) is in knowing default of his obligations under the Federal Rules of Civil Procedure; this Court's Local Rules; and the Court's Order of August 3, 2000, and that summary and declaratory judgment is appropriate and warranted.

2. That Heineken Technical Services, B.V., as assignee and purchaser from Brandt Technology, Inc., is the owner of the Invention and the rightful owner of United States Patent 6,098,689, and that the United States Patent & Trademark Office shall enter and record this Declaratory Judgment as an assignment of all ownership rights in said '689 Patent to Heineken and shall correct the inventorship of said patent by adding the following inventors: Thomas L. Brandt, Daniel N. Willkens, Neal D. Turner, and Harold N. Turner.

3. That German Patent 195 09 984, PCT International Application No. PCT/DE 96/00365 and European Patent Application 819 082 have been effectively transferred from Fiwek to DecoTec International L.P. and further from DecoTec International L.P. to Heineken Technical Services, B.V., and Heineken Technical Services, B.V. is declared the sole and rightful owner of these patent and applications, and that Heineken on its own or through counsel of its choosing is authorized to present this Declaratory Judgment to the appropriate authorities in order that the assignment of the aforesaid German Patent and International and European Patent Applications be recorded by the authorities in accordance with their respective procedures.

4. That pursuant to Rule 37 of the Federal Rules of Civil Procedure, Fiwek shall pay

\$25,000 in sanctions for his continuing failure to abide by this Court's discovery rules
and its Order of August 3, 2000.

So Ordered and Declaratory Judgment Entered this 12 day of ^{Oct.}~~September~~ 2000.


Joseph L. Tauro
Judge, United States District Court

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